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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,306	08/18/2003	Graeme John Proudlar	B-5202 621167-5	4171
22879	7590	07/12/2010	EXAMINER	
HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528				DADA, BEEMNET W
ART UNIT		PAPER NUMBER		
2435				
			NOTIFICATION DATE	DELIVERY MODE
			07/12/2010	ELECTRONIC

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JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GRAEME JOHN PROUDLER

Appeal 2009-006599
Application 10/643,306
Technology Center 2400

Before JAMES D. THOMAS, THU A. DANG, and CAROLYN D.
THOMAS, *Administrative Patent Judges*.

J. THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-43, and 50. We have jurisdiction under 35 U.S.C. § 6(b).

We vacate the rejection before us under 35 U.S.C. § 103 and institute a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b).

Invention

A method of controlling the processing of data is provided comprising defining security controls for a plurality of data items, and applying individualised security rules to each of the data items based on a measurement of integrity of a computing entity to which the data items are to be made available.

(Abstract, Fig. 3).

Representative Claim

33. A method of controlling processing of data, wherein the data comprises a plurality of rules associated with a plurality of data items comprising a set of logically related data items, each data item in the set having a rule associated therewith, said rules acting to individually define usage and/or security to be observed when processing each of the data items in the set of data items, and in which forwarding of the set of data items is performed in accordance with mask means provided in association with the rules.

Prior Art and the Examiner's Rejections

The Examiner relies on the following references as evidence of unpatentability:

Ishizaki	US 2002/0019934 A1	Feb. 14, 2002
Raley	US 2003/0196119 A1	Oct. 16, 2003 (effective filing date of Jan. 16, 2002)

Claims 1-43, and 50 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Raley in view of Ishizaki.

ANALYSIS

We vacate the prior art rejection encompassing all claims on appeal because we conclude that all claims on appeal, claims 1-43, and 50, are “barred at the threshold by § 101.” *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (citing *Diamond v. Diehr*, 450 U.S. 175, 188 (1981)). Therefore, the following new ground of rejection is set forth in this Opinion within the provisions of 37 C.F.R. § 41.50(b).

NEW REJECTION UNDER 35 U.S.C. § 101

PRINCIPLES OF LAW

Statutory Subject Matter

The subject matter of claims permitted within 35 U.S.C. § 101 must be a machine, a manufacture, a process, or a composition of matter. Moreover, our reviewing court has stated that “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If

the claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007); *accord In re Ferguson*, 558 F.3d 1359 (Fed. Cir. 2009). This latter case held that claims directed to a “paradigm” are nonstatutory under 35 U.S.C. § 101 as representing an abstract idea. Thus, a “signal” cannot be patentable subject matter because it is not within any of the four categories. *In re Nuijten*, 500 F.3d at 1357. Laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. at 185. A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). Significantly, “Abstract software code is an idea without physical embodiment.” *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007). The unpatentability of abstract ideas was confirmed by the U.S. Supreme Court in *Bilski v. Kappos*, No. 08-964, 2010 WL 2555192 (June 28, 2010).

With this background in mind, all claims on appeal, claims 1-43, and 50, are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Consistent with our earlier noted invention statement from Appellants’ disclosed abstract, the disclosed and claimed invention is directed to software per se, abstract ideas, abstract concepts, and the like, including data per se, data items, data structures, usage rules, and the abstract intellectual processes associating them within the claims on appeal.

This brief analysis is clearly seen from representative independent claim 33 on appeal. The manner in which the so-called “computer apparatus” of the preamble of independent claim 50 is recited in the body of this claim is characterized as directly reciting in its two clauses “programming for” achieving a certain abstract functionality. Thus, no true hardware structure is recited. The Specification at page 4, lines 19 and 20, also indicates that a “computing entity, either hardware or software, is often called a ‘node’ and this term will appear here and after.” In view of this assessment, the broadly recited “computer apparatus” in independent claim 50 is additionally recited in independent claim 1 on appeal and must be construed in like manner. Corresponding abstract functionalities are recited in all of these independent claims.

In like manner, independent claim 43 recites in its preamble a direct recitation to a computer program that is said to be stored on a computer readable “media”. Besides falling within our earlier analysis, the manner in which this claim is recited in its preamble encompasses signals per se based upon the correlation of this claim to the signals associated with the Internet at page 4 of the “Summary of the Invention” in the principal Brief on appeal as well as its reference to the teachings of the signaling embodiment associated with networks, including the Internet, at Specification page 11 beginning at line 19. Thus, this claim is directed to include communications media. As such, this claim is inclusive of transitory signaling embodiments, which are proscribed by the early-noted case law. The media of this claim include transitory embodiments, such as to comprise signals per se. Note

also the analysis provided by *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

CONCLUSION AND DECISION

We have *pro forma* reversed the outstanding rejection over applied prior art of all claims on appeal, claims 1-43, and 50. We have instituted a new ground of rejection within 37 C.F.R. § 41.50(b). This new rejection of all claims on appeal is based upon 35 U.S.C. § 101 since these claims are directed to non-statutory subject matter.

A new ground of rejection is pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) *Request rehearing*. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

VACATED
37 C.F.R. § 41.50(b)

peb

HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
3404 E. HARMONY ROAD
MAIL STOP 35
FORT COLLINS, CO 80528